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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SVEN KORNFALT, PETER RINGO, ANJA LINDSTEDT, and
KENT AKERMAN

Appeal 2010-008703
Application 10/581,261
Technology Center 1700

Before CHUNG K. PAK, BEVERLY A. FRANKLIN, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 11 and 13 through 20, all of the claims pending in the above-identified application.¹ We have jurisdiction under 35 U.S.C. § 6.

¹ See Supplemental Appeal Brief ("App. Br.") filed February 29, 2010, 2; and Examiner's Answer ("Ans.") filed March 9, 2010, 2.

STATEMENT OF THE CASE

The subject matter on appeal is directed to a flooring system with a plurality of panels having different top decorative surfaces. (*See* Spec. 1, ll. 2-15.) The panels are said to include a carrying panel with edges having means for joining, which means corresponds the edges having snap-joining structure, edges having pre-applied glue, edges defining a conventional tongue and groove joint with pre-applied glue described at pages 1 and 2 of the Specification. (*See* Spec. 1, l. 17 to Spec. 2, l. 2.) Each panel is said to have “an upper decorative surface,” provided at least two “panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite.” (*See* claims 1, 10, 14, and 15 *in conjunction with* Spec. 1, ll. 17-25.) The Specification, at page 2, lines 9-18, states that:

...The thermosetting composite [employed] suitably further comprises hard particles...aluminum oxide, silicon oxide and silicon carbide...having an average particle size in the range [of] 50nm – 150um, in order to increase the wear resistance. The described surface layer is also known as thermosetting laminate which is known for its wear resistance and is also highly resistive to most household chemicals.... *The thermosetting laminate can be provided with almost any décor one may think of, however, the most common décors are different kinds of wood, minerals like marble and granite as well as ceramic tiles.* [(Emphasis added.)]

In other words, at least two panels having two different upper or top decorative surfaces can be formed from one or more materials listed above.

The sizes and shapes of the carrying panels or panels are not described in the (four-page) Specification.

Details of this appealed subject matter are recited in illustrative independent claims 1, 10, 14, and 15 reproduced from the Claims Appendix to the Appeal Brief as shown below:

1. A flooring system comprising a plurality of panels, the panels comprising a carrying panel provided with edges, said edges being provided with means for joining, said carrying panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel and that the flooring system comprises panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite.

10. A flooring system comprising a plurality of panels, the panels comprising a carrying panel provided with edges, said edges being provided with means for joining, said carrying panels further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel and flat the flooring system comprises panels having at least two of the decorative surfaces of the carrying panels being different with one consisting of a thermosetting composite and with another independently consisting of a decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite; wherein the elastomeric foil is selected from the group consisting of thermoplastic elastomers, synthetic rubber and natural rubber.

14. A flooring system comprising a plurality of panels, at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system, each panel, provided with edges, said edges being provided with means for joining, said panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each panel is provided with an upper decorative surface and that the flooring system comprises panels with at least two of the decorative surfaces of the flooring system selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a metal sheet, a fabric, a mineral and a mineral composite wherein at least one of the panels comprises a decorative surface comprising a thermosetting composition and at least one other panel of the flooring system comprises a decorative surface of elastomeric foil.

15. A flooring system comprising a plurality of panels, at least one panel differing in at least one of aesthetic or mechanical properties from another panel of said system, each panel provided with edges, said edges being provided with means for joining, said panel further being provided with an upper side and a lower side wherein the flooring system comprises a plurality of panels where each panel is provided with an upper decorative surface and that the flooring system comprises panels wherein at least a portion of the panels comprise an elastomeric foil as the decorative surface while the rest of the panels have a high-gloss wood design of thermosetting composite.

As evidence of unpatentability of the claimed subject matter, the Examiner relies on the following documents at pages 2 and 3 of the Answer:

Bettinger	US 3,811,237	May 21, 1974
Martensson	US 6,397,547 B1	Jun. 4, 2002
Hansson	US 6,465,046 B1	Oct. 15, 2002
Sjoberg '812	US 2004/0170812 A1	Sep. 2, 2004
Grau '181	US 2005/0115181 A1	Jun. 2, 2005

Sjoberg '906
Grau '256

WO 02/47906 A1
WO 03/060256 A1

Jun. 20, 2002
Jul. 24, 2003

Appellants seek review of the following grounds of rejection set forth by the Examiner at pages 3 through 19 of the Answer:

1. Claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Grau '256 (as evidenced by Grau '181);
2. Claims 1, 4 through 6, 8 through 10, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hansson;
3. Claims 1, 10, 13, and 16 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as unpatentable over, the disclosure of Sjoberg '812;
4. Claims 1 through 3, 7, and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Martensson and Sjoberg '812;
5. Claims 4 through 9 and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Hansson;
6. Claim 14 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Sjoberg '906;
7. Claim 15 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Sjoberg '812;
8. Claim 17 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181);

9. Claims 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg ‘812 and Bettinger;

10. Claims 18 through 20 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Grau ‘256 (as evidenced by Grau ‘181) and Sjoberg ‘906;

11. Claim 19 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg ‘812, Bettinger, and Martensson;

12. Claims 1 through 10 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg ‘906 and ‘812; and

13. Claim 20 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg ‘812, Bettinger, and Sjoberg ‘906. (*See App. Br. 5-6.*)

RELEVANT FACTUAL FINDINGS, PRINCIPLES OF LAW, ISSUE,
ANALYSIS, AND CONCLUSION

1. Claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Grau ‘256 (as evidenced by Grau ‘181).

Appellants question the Examiner’s reliance on Grau ‘181 as the English translation of Grau ‘256 (French language document) which is used as “prior art” against claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b) (*App. Br. 7*).

Thus, the first critical question raised is: Has the Examiner erred in relying Grau ‘181 as the English translation of Grau ‘256 used in rejecting claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b)? On this record, we answer this question in the negative.

As is apparent from pages 19 and 20 of the Answer, the Examiner has supplied a factual proof for finding that both Grau ‘256 and ‘181 correspond

to the same document, PCT/FR03/00025 filed on January 7, 2003.

Appellants have not disputed the accuracy of this proof. Nor have Appellants shown any inconsistencies between the disclosures of Grau ‘181 and Grau ‘256.

Under these circumstances, it is not unreasonable for the Examiner to rely on Grau ‘181 as the English translation of Grau ‘256 (the French language document) used in rejecting claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b).

Appellants also contend that Grau ‘256 does not teach a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as required by claim 1 (App. Br. 7).

Thus, the second critical question is: Has the Examiner erred in finding that Grau ‘256 describes a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as required by claim 1? On this record, we answer this question in the negative².

As indicated *supra*, the plain language of claim 1, as well as pages 1 and 2 of the supporting Specification, indicates that at least two of the

² Our reference to Grau ‘256 is to the corresponding English translation of record, Grau ‘181.

plurality of floor panels have decorative surfaces which are different from one another and can be formed from the same material or different materials selected from the group consisting of “a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite.” The claim, however, does not indicate that the panels and the carrying panel themselves are the same or different sizes and/or shapes and/or are different from or identical to one another in terms of shapes and/or sizes.

As is apparent from page 3-5 of the Answer, the Examiner has correctly found that Grau ‘256 teaches a flooring system comprising a plurality of strips (e.g., 3, 4) constituting framing modules (1 or 40) and tiles (7 or 41) corresponding to the claimed plurality of panels having unknown sizes and shapes. (*See also* Grau ‘181, pp. 5-6, paras. 0061 and 0063 and p. 9, para. 0084, together with its Figs. 1, 2 and 11.) The Examiner has also correctly found that Grau ‘256’s Figure 3 illustrates a flooring system having tiles 7b is made of carpet or cloth (the corresponding to the claimed fabric) and strips constituting the framing modules 1bis having a non-carpet decorative lamina 6. (*See* Ans. 4-5 and Grau ‘181, Figure 3 and p. 6, paras. 0065-0068.) Further, the Examiner has correctly found that Grau ‘256 teaches that the strips constituting the flaming modules having upper decorative surfaces can be formed from a wooden lamina, a lamina made of laminate, a metal lamina, a silica mortal (mineral), ceramic or terracotta (mineral composite), a lamina made of carpet (fabric), and PVC (thermoplastic). (*See* Ans. 4-5 and Grau ‘181, p. 4, para. 0038.) According to Grau ‘256:

[I]t would be desirable to be able to associate various types of framing modules, such as laminas made of wood or laminate or else metal laminas, and any types of tiles-such as terracotta tiles, ceramic tiles, etc., or tiles made of carpet or other synthetic material such as PVC, or tiles made of natural fibres...or else tiles made of glass. *Such a covering would allow anyone to compose, from elements produced and marketed industrially, a unique floor covering according to their own tastes.* [(Emphasis added.) (See Grau ‘181, p. 1, para. 003.)]

Given the above teachings, we concur with the Examiner that one of ordinary skill in the art would have readily envisaged a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as required by claims 1, 2, 7 and 13 from the disclosure of Grau ‘256 within the meaning of 35 U.S.C. §102(b).

Appellants also contend that Grau ‘256 does not teach a carrying panel having edges defining the snap-fitting joining means recited in claim 2 (App. Br. 8).

Thus, with respect to claim 2, the third critical question is: Has the Examiner erred in finding that Grau ‘256 describes a flooring system comprising a carrying panel having edges defining the snap-fitting joining structure recited in claim 2? On this record, we answer this question in the negative.

As indicated *supra*, the plain language of claim 1 indicates that its flooring system comprises at least one carrying panel with edges defining means for joining. The term “edges being provided with means for joining”

recited in claim 1 is interpreted as the corresponding edges having conventional snap-joining structures, pre-applied glue, or conventional tongue and groove joints with pre-applied glue described at pages 1 and 2 of the Specification or equivalents thereof in accordance with 35 U.S.C. § 112, ¶ 6. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (*en banc*). Claim 2 further limits such carrying panel as having edges defining snap-joining structures.

As correctly found by the Examiner at pages 4 and 23 of the Answer, Grau ‘256 illustrates at its Figure 10 strips forming framing modules (corresponding to the claimed carrying panels), which have at their edges particularly designed and shaped male and female members capable of snap-joining functionality (a female structure defined by a recessed joining structure 34 comprising a vertical mortice 37 for receiving a tenon 36 of a male joining structure 35). (*See also* Grau ‘181, pp. 8-9, para. 0081). In describing such male-female joint structures shown in Figure 10, Grau ‘256 states that:

Given the shape of the tenon 36 and mortice 37 defining a head 61 of the tenon and a mating head 60 of the mortice, the person who installs the floor covering has to exert a certain pressure on the end 12bis of the module 1bis to enable the fitting together, by tapping on the said end using his foot or any suitable object (small mass for example). Moreover, it is preferable for at least one of the jointing [sic.] structures, preferably the tenon 36, to be designed in a slightly flexible and elastic material to facilitate the fitting together of the structures and guarantee the effectiveness of the locking means (shoulders 38 and 39). [(*See* Grau ‘181, p. 9, para. 0081.)]

Consistent with such description, Grau ‘256 also teaches that such male and female joint structures are “detachable” locking means and that the tenon of

the male joining structure preferably made of an elastically deformable material “has at least one horizontal shoulder defining a head of the tenon intended to fit with force into a mating head of the mortice in order to prevent the vertical relative displacement of the mating jointing [sic] structures.” (See Grau ‘181, paras. 0036 and 0037.)

Thus, it can be inferred from the disclosure of Grau ‘256 that its male and female joint structures are snap-joining structures. *In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (In determining whether a reference anticipates the claimed invention, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”)

2. Claims 1, 4 through 6, 8 through 10, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hansson.

Appellants do not dispute the Examiner’s finding that Hansson teaches a flooring system comprising a plurality of panels, including at least one carrying panel having edges defining the claimed joining means. (*Compare* Ans. 6 with App. Br. 9.) Rather, Appellants contend that Hansson does not teach a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as required by claim 1 (App. Br. 9). Appellants also contend that Hansson does not teach a flooring system comprising “panels having at least two of the decorative surfaces of the carrying panels being different with one consisting of a thermosetting composite and with another independently consisting of a

decorative material selected from the group consisting of a thermosetting composite...” as required by claim 10 (App. Br. 9-10).

Thus, the dispositive question is: Has the Examiner erred in finding that Hansson describes a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite...” as required by claims 1 and 10? On this record, we answer this question in the negative.

As indicated *supra*, the plain language of claims 1 and 10, as well as pages 1 and 2 of the supporting Specification, indicates that at least two panels or at least two carrying panels have decorative surfaces which are different from one another and which can be formed from the same material, i.e., a thermosetting composite, or different materials. For example, claims 1 and 10 include different decorations or patterns provided to the same thermosetting composite layers (thermosetting laminates) formed on two different panels. These claims do not limit the size and shape of the panels and the carrying panels. The claimed panels and carrying panels can have the same or different sizes and shapes and can be identical to or different from one another.

As correctly found by the Examiner at page 7 of the Answer, Hansson teaches applying thermosetting composite layers 2 (a UV or electron beam curing lacquer such as epoxy, or maleimide lacquer containing hard particles, e.g., aluminum oxide, silicon oxide or silicon carbide in the range of 10 nm to 150 um) on two or more panels and embossing or printing different parts of a world map on those panels according to the digital data stored in a computer. (See Hansson, col. 3, ll. 40-66, col. 4, l. 66 to col. 5, l.

38, col. 6, l. 65-col. 7, 19 and Process scheme 1 shown at cols. 7 and 8.)

Thus, we concur with the Examiner that Hansson describes a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite” as required by claims 1 and 10 within the meaning of 35 U.S.C. § 102(b).

3. Claims 1, 10, 13, and 16 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as unpatentable over, the disclosure of Sjoberg ‘812.

Appellants do not dispute the Examiner’s finding that Sjoberg ‘812 teaches a flooring system comprising a plurality of panels, including at least one carrying panel having edges defining the claimed joining means. (*Compare* Ans. 6 *with* App. Br. 9.) Rather, Appellants contend that Sjoberg ‘812 does not teach a flooring system comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite” as required by claim 1 (App. Br. 10). Appellants also contend that Sjoberg ‘812 does not teach a flooring system comprising “panels having at least two of the decorative surfaces of the carrying panels being different with one consisting of a thermosetting composite and another independently consisting of a decorative material selected from the group consisting of a thermosetting composite...” as required by claim 10 (*id.*).

Thus, the dispositive question is: Has the Examiner erred in finding that Sjoberg ‘812 describes or would have suggested a flooring system

comprising “panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite...” as required by claims 1 and 10 within the meaning of 35 U.S.C. §102(b) or 103(a)? On this record, we answer this question in the negative.

As correctly found by the Examiner at pages 8 and 9 of the Answer, Sjoberg ‘812 teach a flooring system comprising having at least two panels or carrying panels having different visual decorative surfaces and are independently having a decorative material consisting of a thermosetting composite (an overlay layer comprising a thermosetting melamine-formaldehyde resin with hard particles, i.e., silica, aluminum oxide and /or silicon carbide particles with an average size of 5-60 um) as required by claims 1 and 10. (*See* Sjoberg ‘812, Figs. 2 and 9 and p. 1, paras. 0006-0009.) Thus, we concur with the Examiner that Sjoberg ‘812 describes a flooring system comprising panels having at least two of the decorative surfaces being different from each other and independently consisting of a thermosetting composite as required by claims 1 and 10 within the meaning of 35 U.S.C. § 102(b) or 103(a) .

Appellants separately contend that Sjoberg ‘812 does not teach or would have suggested the high gloss wood design recited in claim 16. (App. Br. 10.)

Thus, with respect to claim 16, the dispositive question is: Has the Examiner erred in finding that Sjoberg ‘812 describes or would have suggested providing at least one panel having a decorative surface of a thermosetting composite in the form of the high gross wood design within

the meaning of 35 U.S.C. §102(b) or 103(a)? On this record, we answer this question in the affirmative.

Although Figures 1 and 9 of Sjoberg ‘812 illustrate wood design panels, the Examiner has not shown that they are high gloss wood design panels. Paragraph 007 of Sjoberg ‘812 referred to by the Examiner does not mention high gloss wood design panels. (*See* Ans. 8-9 and 24.) Nor has the Examiner cited any prior art references or taken any official notice to show that such high gloss wood panels were known at the time of the invention. (*See Id.*) Moreover, Appellants have not acknowledged that such high gloss wood panels were known at the time of the invention.³ (*See* Spec. and App. Br. in their entirety.)

Under these circumstances, we are constrained to agree with Appellants that Sjoberg ‘812 neither teaches nor would have suggested providing at least one panel having a decorative surface of a thermosetting composite in the form of the high gloss wood design as required by claim 16 within the meaning of 35 U.S.C. §102(b) or 103(a).

4. Claims 1 through 3, 7, and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Martensson and Sjoberg ‘812.

Appellants do not dispute the Examiner’s finding that Martensson teaches a flooring system comprising a plurality of panels having decorative surfaces, with carrying panels having edges defining snap-joining structures with pre-applied glue. (*Compare* Ans. 10 and 11 *with* App. Br. 10 and 11.)

³ Since Appellants argue that the Examiner has not presented such a fact to support his or her rejection at pages 10 and 12 of the Appeal Brief, it appears to be Appellants’ position that such information was material to the Examiner’s rejection of claim 16.

Nor do Appellants dispute the Examiner's determination that it would have been obvious to employ the different decorative surface designs for the plurality of panels of the flooring system taught by Sjoberg '812 on the plurality of panels taught by Martensson. (*Compare* Ans. 10 and 11 *with* App. Br. 10 and 11.) Rather, Appellants contend that such combination would not have resulted in "panels having at least two of the decorative surfaces being different from each other and independently consisting of decorative material selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil, a fabric, a mineral and a mineral composite" as required by claim 1 since none of the prior art relied upon teaches such limitation. (App. Br. 11.)

Thus, the dispositive question is: Has the Examiner erred in finding that Sjoberg '812 would have suggested using "panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from the group consisting of a thermosetting composite..." to form a flooring system, inclusive of that taught by Martensson, as required by claim 1 within the meaning of 35 U.S.C. §102(b) or 103(a)? On this record, we answer this question in the negative for the factual findings and reasons set forth *supra*.⁴

Accordingly, we concur with the Examiner that the combined disclosures of Martensson and Sjoberg '812 would have suggested the

⁴ Although Appellants contend at page 11 of the Appeal Brief that Sjoberg '812 does not teach the limitation recited in claim 10, the Examiner's rejection based on the combined disclosures of Martensson and Sjoberg '812 does not include claim 10. *See* Ans. 10.

claimed flooring system comprising panels having at least two of the decorative surfaces being different from each other and independently consisting of a thermosetting composite as required by claim 1 within the meaning of 35 U.S.C. § 103(a) .

5. Claims 4 through 9 and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of the Grau ‘256 (as evidenced by Grau ‘181) and Hansson.

Appellants do not question that Hansson teaches forming the different decorative surfaces of flooring panels via applying the claimed thermosetting composite layers on the surfaces of the panels and embossing or patterning different designs to those layers. (*See* Ans. 12 and App. Br. 11.) Nor do Appellants question that it would have been obvious to employ such differently patterned thermosetting composite layers on the tiles (panels) and framing module forming strips (panels) taught by Grau ‘256. (*See* Ans. 12 and App. Br. 11.) Rather, Appellants contend that neither Grau ‘256 nor Hansson teaches or suggests employing at least two different materials to form the decorative surfaces of at least two panels (App. Br. 11).

Thus, the dispositive question raised is: Does Appellants’ argument that neither Grau ‘256 nor Hansson teaches or suggests employing at least two different materials to form the decorative surfaces of at least two panels show reversible error in the Examiner’s determination that the collective teachings of Grau ‘256 and Hansson would have rendered the claimed subject matter obvious to one of ordinary skill in the art? On this record, we answer this question in the negative.

As indicated *supra*, the plain language of claims 1 and 4, as well as pages 1 and 2 of the supporting Specification, indicates that at least two panels have decorative surfaces which are different from one another and which can be formed from the same material (e.g., a thermosetting composite) or different materials. (*See also* Ans. 4.) Thus, Appellants' argument fails to show reversible error in the Examiner's determination inasmuch as it based on limitations that do not appear in the claims. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (“[A]ppellant's arguments fail from the outset because . . . they are not based on limitations appearing in the claims.”). (Emphasis added.)

Even were we to determine that the claims require at least two different decorative surfaces of at least two panels be formed from different decorative materials, the outcome of our decision would not be altered. As indicated *supra*, Grau ‘256 teaches that:

[I]t would be desirable to be able to associate various type of framing modules such as laminas made of wood or laminate or else metal laminas, and any types of tiles-such as terracotta tiles, ceramic tiles, etc., or tiles made of carpet or other synthetic material such as PVC, or tiles made of natural fibres...or else tiles made of glass. *Such a covering would allow anyone to compose, from elements produced and marketed industrially, a unique floor covering according to their own tastes.* [(Emphasis added.) (*See* Grau ‘181, p. 1, para. 0003.)]

Thus, the collective teachings of Grau ‘256 and Hansson would have led one of ordinary skill in the art to form decorative surfaces of the tiles (panels) and framing module forming panels with the same material or different decorative materials according to individuals' desired or artistic tastes to

arrive at the claimed subject matter within the meaning of 35 U.S.C. § 103(a).

6. Claims 14 and 18 through 20 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau ‘256 (as evidenced by Grau ‘181) and Sjoberg ‘906.

The Examiner takes the position that it would have been obvious to employ the elastomeric foil taught by Sjoberg ‘906 as part of the decorative surfaces of the tiles or strips taught by Grau ‘256 (Ans. 13 and 16-17). On the other hand, Appellants contend that the Examiner has not shown that one of ordinary skill in the art would have been led to employ the elastomeric foil taught by Sjoberg ‘906 as part of the decorative surfaces of the tiles or strips taught by Grau ‘256 (App. Br. 11-12).

Thus, the dispositive question raised is: Has the Examiner erred in finding that one of ordinary skill in the art would have been led to employ the elastomeric foil taught by Sjoberg ‘906 as part of the decorative surfaces of the tiles or strips taught by Grau ‘256? On this record, we answer this question in the affirmative.

As correctly pointed out by Appellants at pages 11 through 13 of the Appeal Brief, the Examiner has not shown that the elastomeric foil taught by Sjoberg ‘906 is useful as the decorative or upper surfaces of the tiles and the framing module forming strips taught by Grau ‘256. In particular, Sjoberg ‘906 relied upon by the Examiner for an elastomeric foil is directed to employing an elastomeric foil between a core and a decorative thermosetting laminate for the sound dampening purpose. (*See* Sjoberg ‘906, pp. 1-2.) Thus, we concur with Appellants that the Examiner has not demonstrated that one of ordinary skill in the art would have been to employ the

elastomeric foil taught by Sjoberg '906 as part of the decorative or upper surfaces of the tile or strip panels taught by Grau '256 within the meaning of 35 U.S.C. § 103(a).

7. Claims 15 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Sjoberg '812.

The Examiner takes the position that it would have been obvious to employ either high gloss or non-gloss wood decorative designs on the upper surfaces of the tiles or strips taught by Grau '256 (Ans. 14). On the other hand, Appellants contend that the Examiner has not shown that the collective teachings of Grau '256 and Sjoberg '812 would have led one of ordinary skill in the art to employ the high gloss wood design recited in claim 15 (App. Br. 10).

Thus, the dispositive question is: Has the Examiner erred in finding that the collective teachings of Grau '256 and Sjoberg '812 would have led one of ordinary skill in the art to employ the high gloss wood design recited in claim 15 to form a flooring system within the meaning of 35 U.S.C. §103(a)? On this record, we answer this question in the affirmative.

As correctly argued by Appellants at page 12 of the Appeal Brief, the Examiner has not shown that neither Grau '256 nor Sjoberg '812 teaches or would have suggested the high gloss wood design recited in claim 15. Nor has the Examiner made any finding that such high gloss wood panels were known at the time of the invention.

Under these circumstances, we are constrained to agree with Appellants that the Examiner has not demonstrated that the collective teachings of Grau '256 and Sjoberg '812 would have led one of ordinary

skill in the art to employ the high gloss wood design recited in claim 15 within the meaning of 35 U.S.C. §103(a).

8. Claim 17 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Grau ‘256 (as evidenced by Grau ‘181).

Appellants contend that Grau ‘256 does not teach or suggest “at least two panels of a flooring system made of the different materials with one of them being a needle loom carpe as in claim 17 and the other being selected from the Markush Group specified in independent claim 1” (App. Br. 12).

Thus, the dispositive question raised is: Has the Examiner erred in finding that Grau ‘256 would have suggested “at least two panels of a flooring system made of the different materials with one them being a needle loom carpet as in claim 17 and the other being selected from the Markush Group specified in independent claim 1” within the meaning of 35 U.S.C. §103(a)? On this record, we answer this question in the negative.

As indicated *supra*, Grau ‘256’s Figure 3 illustrates a flooring system having tiles 7*bis* (panels) made of carpet or cloth (the corresponding to the claimed fabric) and framing module forming strips (panels) 1*bis* having a non-carpet decorative lamina 6, i.e., the claimed mineral material. (*See* Ans. 4-5 and Grau ‘181, Figure 3 and p. 6, paras. 0065-0068.) Although Grau ‘256 does not specifically mention the claimed needle loom carpet, it broadly teaches using any known carpet tiles (panels) in forming its flooring system. Moreover, Appellants have not specifically disputed the Examiner’s finding that many different carpets, including the claimed needle loom carpet, were known to one of ordinary skill in the art at the time of the invention. (*Compare* Ans. 14-15 with App. Br. 12.) Finally, as indicated *supra*, Grau ‘256 teaches that:

[I]t would be desirable to be able to associate various type of framing modules such as laminas made of wood or laminate or else metal laminas, and any types of tiles-such as terracotta tiles, ceramic tiles, etc., or tiles made of carpet or other synthetic material such as PVC, or tiles made of natural fibres...or else tiles made of glass. *Such a covering would allow anyone to compose, from elements produced and marketed industrially, a unique floor covering according to their own tastes.* [(Emphasis added.) (See Grau ‘181, p. 1, para. 0003.)]

Given the above teachings, we concur with the Examiner that one of ordinary skill in the art would have been led to employ any known carpet tiles, including the known needle loom carpet tiles, and mineral or mineral composite framing panels according to individuals’ desired or artistic tastes to arrive at the claimed subject matter within the meaning of 35 U.S.C. § 103(a).

9. Claims 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg ‘812 and Bettinger.

Appellants do not question the Examiner’s finding that Bettinger teaches floor panels having upper decorative surfaces, which are made of either carpet or other materials, such as vinyl. (*Compare* Ans. 15 with App. Br. 13.) Nor do Appellants argue that the use of the needle loom carpet was not known or not obvious at the time of the invention. (*See* App. Br. 13.) Rather, Appellants contend that one of ordinary skill in the art would not have been led to employ floor panels having decorative surfaces formed of both a needle loom carpet and other materials such as a thermosetting composite as required by claims 17 and 18 (App. Br. 13).

Thus, the dispositive question is: Has the Examiner erred in finding that one of ordinary skill in the art would have been led to employ panels having decorative surfaces formed of a needle loom carpet and a thermosetting composite as required by claims 17 and 18 from the collective teachings of Sjoberg '812 and Bettinger? On this record, we answer this question in the negative.

As indicated *supra*, Sjoberg '812 teaches floor panels having decorative surfaces made of a decorative material such as a thermosetting composite (an overlay layer comprising a thermosetting melamine-formaldehyde resin with hard particles, i.e., silica, aluminum oxide and /or silicon carbide particles with an average size of 5-60 um). Appellants also do not question the Examiner's finding that Bettinger teaches floor panels having upper decorative surfaces, which are made of either known carpets, inclusive of the needle loom carpet. Nor do Appellants question the official notice taken by the Examiner at page 15 of the Answer that:

[I]t was known at the time Applicant's invention was made that in office environments people have a preference for flooring surfaces that are carpeted in some regions and smooth in the immediate vicinity of the desk chair so as [to] allow for easy movement of a desk chair, especially one that has rollers.
[(Compare Ans. 15 with App. Br. 13.)]

Under the above circumstances, we concur with the Examiner that one of ordinary skill in the art would have been led to employ both the needle loom carpet and the thermosetting composite layer as the upper decorative surfaces of the floor panels of the office flooring system within the meaning of 35 U.S.C. § 103(a). *See KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)(quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282

(1976)(“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.”)

10. Claim 19 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg ‘812, Bettinger, and Martensson.

Appellants contend that:

Applicant is not merely claiming a floor comprising a thermoplastic foil[,] but rather a flooring system with at least tow [sic., two] floor panels[]where the thermoplastic foil is present on at least one floor panel and a different material is present on another floor panel. [(See App. Br. 13.)]

Thus, the dispositive question raise is: Has the Examiner erred in finding that one of ordinary skill in the art would have been led to employ floor panels having upper surfaces made of two different materials, i.e., a thermoplastic foil and a thermosetting laminate (thermosetting composite) to form the claimed flooring system within the meaning of 35 U.S.C. § 103(a)? On this record, we answer this question in the negative.

As correctly found by the Examiner at page 17 of the Answer, Martensson teaches employing either a thermoplastic foil, such as polyvinyl chloride, or a thermosetting laminate as the upper surfaces of floor panels to provide a flooring system that does not absorb water. (*See also* Martensson col. 3, ll. 17-28). Appellants also do not dispute the Examiner’s finding that both Bettinger and Sjoberg ‘812 teach that floor panels can have decorative surfaces made of either polyvinyl material or a thermosetting composite.

Given that both the polyvinyl foil and the thermosetting laminate (thermosetting composite) are taught by the prior art references to be useful

for the upper surfaces of the floor panels for the same decorative and/or non-water absorbing purposes, we concur with the Examiner that one of ordinary skill in the art would have been led to use a polyvinyl foil and a thermosetting laminate to form the upper surfaces of different floor panels, with a reasonable expectation of successfully forming a floor system having desired decorative impressions and/or non-water absorbing properties. *See KSR*, 550 U.S. at 417 (*quoting Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976) (“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.”))

11. Claims 1 through 10 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg ‘906 and ‘812.

As indicated above, Sjoberg ‘906 and ‘812 teach employing a thermosetting composite material in forming the decorative upper surfaces of floor panels, with Sjoberg ‘812 suggesting the formation of different decorative patterns for the different floor panels.

Appellants contend that the collective teachings of Sjoberg ‘906 and ‘812 would not have suggested forming the two different decorative surfaces of at least two panels with two different materials (App. Br. 14).

Thus, the dispositive question is: Do claims 1 and 10 require forming the two different decorative surfaces of at least two panels with two different materials? On this record, we answer this question in the negative.

As indicated *supra*, the plain language of claims 1 and 10, including pages 1 and 2 of the supporting Specification, indicates that the claimed different decorative surfaces of the panels can be formed from a single

material, i.e., a thermosetting composite, or different materials. It follows that Appellants have not identified any reversible error in the Examiner's determination that the collective teachings of Sjoberg '906 and '812 would have rendered the subject matter recited in claims 1 and 10 obvious to one of ordinary skill in the art within the meaning of 35 U.S.C. § 103(a).

12. Claim 20 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg '812, Bettinger, and Sjoberg '906.

The Examiner takes the position that it would have been obvious to employ the elastomeric foil taught by Sjoberg '906 as part of the decorative surfaces of the panels suggested by Sjoberg '812 and Bettinger (Ans. 19). On the other hand, Appellants contend that the Examiner has not shown that one of ordinary skill in the art would have been led to employ the elastomeric foil taught by Sjoberg '906 as part of the decorative surfaces of the panels taught by Sjoberg '812 and Bettinger (App. Br. 14).

Thus, the dispositive question raised is: Has the Examiner erred in finding that one of ordinary skill in the art would have been led to employ the elastomeric foil taught by Sjoberg '906 as part of the decorative surfaces of the panels taught by Sjoberg '812 and Bettinger? On this record, we answer this question in the affirmative.

As correctly pointed out by Appellants at pages 11 through 13 of the Appeal Brief, the Examiner has not shown that the elastomeric foil taught by Sjoberg '906 is useful as the decorative or upper surfaces of the panels taught or suggested by Sjoberg '812 and Bettinger. In particular, Sjoberg '906 relied upon by the Examiner for an elastomeric foil is directed to employing an elastomeric foil between a core and a decorative thermosetting laminate for the sound dampening purpose. (*See* Sjoberg '906, pp. 1-2.)

Thus, we concur with Appellants that the Examiner has not demonstrated that one of ordinary skill in the art would have been led to employ the elastomeric foil taught by Sjoberg '906 as part of the decorative or upper surfaces of the tile or strip panels taught by Sjoberg '812 and Bettinger within the meaning of 35 U.S.C. § 103(a).

ORDER

In view of the foregoing, it is

ORDERED that the decision of the Examiner rejecting claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Grau '256 (as evidenced by Grau '181) is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 1, 4 through 6, 8 through 10, and 13 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Hansson is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 1, 10, and 13 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as unpatentable over, the disclosure of Sjoberg '812 is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claim 16 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as unpatentable over, the disclosure of Sjoberg '812 is REVERSED;

FURTHER ORDERED the decision of the Examiner rejecting claims 1 through 3, 7, and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Martensson and Sjoberg '812 is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 4 through 9 and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Hansson is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claim 14 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Sjoberg '906 is REVERSED;

FURTHER ORDERED the decision of the Examiner rejecting claim 15 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) and Sjoberg '812 is REVERSED;

FURTHER ORDERED the decision of the Examiner rejecting claim 17 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Grau '256 (as evidenced by Grau '181) is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg '812 and Bettinger is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 18 through 20 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Grau '256 (as evidenced by Grau '181) and Sjoberg '906 is REVERSED;

FURTHER ORDERED the decision of the Examiner rejecting claim 19 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Sjoberg '812, Bettinger, and Martensson is AFFIRMED;

FURTHER ORDERED the decision of the Examiner rejecting claims 1 through 10 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg '906 and '812 is AFFIRMED;

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FURTHER ORDERED the decision of the Examiner provisionally rejecting claim 20 under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Sjoberg '812, Bettinger, and Sjoberg '906 is REVERSED; and

FURTHER ORDERED that no time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED-IN-PART

kmm